

REMARKS

Claims 1-4, 7, and 18-19 are presently pending in the subject application. Claims 5-6 have been canceled. Claims 8-17 are withdrawn. Claim 1 has been amended to place the claims in condition for allowance.

The Applicants thank the Examiner for allowance of Claims 3-4 and 18-19.

Claims 1-2 and 5-6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,658,472 to Ransburg. Claims 1-2 and 5-6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,658,009 to Ransburg. Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ransburg '472 or '009 further in view of U.S. Patent No. 5,181,661 to Wollard.

Responding to Applicants' previous remarks, the Final Office Action maintained the rejections as to claims 1-2 and 5-6, asserting that the referenced limitations are "part of an intended use recitation" and do not "impart patentability to the claimed apparatus." *See* Office Action, p. 6, ¶9. To expedite allowance, Applicants have amended independent claim 1 to recite the limitation of a "stent holder," which is not a recitation of "an intended use." Thus, it should be treated as a claim limitation with due patentable weight accorded to it. *See In re Otto*, 312 F.2d 937, 938, 136 U.S.P.Q. 458, 459 (C.C.P.A. 1963); *In re Land*, 368 F.2d 866 (C.C.P.A. 1966); *In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1971). Accordingly, Applicants assert that the claims are placed in condition for allowance.

The term "stent holder" limits the structure of the invention to only those structures used to hold a stent in a position suitable for coating applications in a manner that minimizes compressive and tensile forces applied when holding delicate stents. *See* Application, ¶ 0017. Stents are small, tube-like medical devices that are typically designed to be maneuvered to a desired location within a lumen of the patient's body, such as an artery, and then expanded to provide internal support for the lumen. *Id.*, ¶ 0003. As such, due to the delicate nature of the stents, they must be held in a manner that avoids buckling, collapse or premature expansion of the stent. Stents may also be coated to deliver a precise therapeutic drug dosage to tissue. *Id.*, ¶ 0002. As a consequence, a stent holder must hold a stent in a manner that permits even and open

exposure to stent surfaces to be coated in order to provide uniform dosing of therapeutic drug to tissue. For example, a stent holder should hold a stent in a manner that avoids spray "shadowing," i.e., incomplete coating spray application onto the stent due to structural elements of the holder that may block the spray.

Thus, stent holding structures possess unique structures and properties that facilitate secure retention of delicate stents during the application of a coating, while minimizing compressive and tensile forces applied to the stents and disruptions to the coating due to obstructions caused by the holder. Accordingly, recitation of the term "stent holder" limits the structure of the claimed invention within the field of fixtures and the term should be accorded patentable weight.

The specification provides non-limiting examples of such stent holder devices at ¶¶ 0017 - 0019, such as two-piece stent holders comprising a base portion 2a and a top portion 2b (¶0018), "T-shaped" stent holder portions (¶0019), one-piece holders (¶0019), and the various stent holders described in U.S. Patent Application Serial No. 10/198,094 (¶0017), which is incorporated by reference.

In addition, Applicants' recitation of "stent holders" also recognizes differences between the claimed invention and Ransburg '472 and Ransburg '009, and thus should be treated as a claim limitation with patentable weight for this reason as well. *See In re Otto*, 312 F.2d 937, 938, 136 U.S.P.Q. 458, 459 (C.C.P.A. 1963) (if the recited purpose or intended use results in a difference between the claimed invention and the prior art, the recitation serves to limit the claim). Recitation of "stent holder" recognizes and emphasizes the difference between the claimed invention and each of the Ransburg references, neither of which disclose or suggest a stent holder.¹ Thus, the term "stent holder" should be accorded patentable weight as a claim limitation, and not merely as an "intended use."

¹ For the same reasons previously asserted by the Applicants in their Response to June 15, 2006 Office Action, amended claim 1 and dependent claim 2 are patentably distinct over the '472 and '009 patents because neither Ransburg patent disclose or suggest a "stent holder," as claimed. Each element set forth in the claim must be found in any single prior art reference. *See* MPEP 2131. In addition, for the same reasons, dependent claim 7 is patentably distinct over the Ransburg '472 or '009 patents in view of Wollard because none of the Ransburg or

Further, to the extent “stent holder” is considered merely functional language, Applicants respectfully submit that disregarding the “stent holder” limitation is contrary to law:

[A]t times an Examiner may refuse to provide patentable weight to functional limitations, essentially ignoring many of the limitations of the claim. In this instance, the Examiner may remove the most important features when determining whether the claim is anticipated. Applicants should be aware, however, that an Examiner is not permitted to dissect the claim and remove the functional limitations before determining anticipation.

Patent Prosecution: Practice & Procedure Before the U.S. Patent Office, I. Donner (2d ed.1999), p. 478 (emphasis supplied). According to precedent, to the extent “stent holder” may be regarded as functional language, it should be given patentable weight. *See In re Land*, 368 F.2d 866 (C.C.P.A. 1966); *In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1971).

Finally, consistent with the stent holder limitation of the amended claim, the preamble of claim 1 has been amended to recite an “apparatus for electrostatic spray application of a coating material to a stent.” Terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989).

It is respectfully submitted that, in view of the foregoing amendment and remarks, this amendment is in condition for entering. Issuance of a communication confirming the entering of this amendment is earnestly solicited.

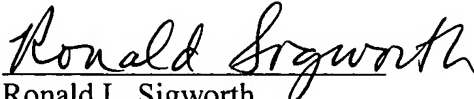
Wollard references disclose “stent holders.” Wollard is directed to coating “the interior of containers ... for baking bread and other confectionery.” *See* Wollard, col. 1:4-10.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge Kenyon & Kenyon LLP Deposit Account No. 11-0600 for any applicable fee.

Should there be any questions concerning this matter, the Examiner is invited to contact the Applicant's undersigned attorney.

Respectfully submitted,

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